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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,820

09/26/2003

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EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,820	Applicant(s) JONES, MICHAEL C.	
	Examiner JAMES L. SWIGER III	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 14, 20-22, 24-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 14, 20-22, 24-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/22/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 20 is objected to because of the following informalities: The claim is incomplete because it is missing a period at the end of the claim. Appropriate correction is required.

Claim 27 is objected to because of the following informalities: The claim is incomplete because it is missing a period at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 20-22, 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 12 of claim 6, applicant states that "said second component are separable..." It is unclear what applicant is referring to with a plural verb choice. Appropriate action is required.

Claim 6 recites the limitation "the implant" in line 15. There is insufficient antecedent basis for this limitation in the claim. Applicant is positively referring to the implant. However, there is no positive recitation of any implant in the claim. Any mention of the implant is found in the preamble as a functional limitation of the instrument.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14, 27, 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Wack (EP 0992225 A2). Wack discloses an instrument for compacting bone having a first component (82) that defines a longitudinal axis and a body which has an outer periphery and is also tapered along the longitudinal axis (see section that enters into the intramedullary of the canal). Wack also discloses components which could be second and third components (see alternating panels 80 shown in Fig. 1) which are slidably mounted onto the first component. The components are also tapered. Wack also discloses a restraining portion on the first component, which is considered the flattened surface on the side 60. Alternatively, there is a similar surface on the other side. The matching face of the 2nd and 3rd components are considered the cooperating portions which interact with the first component. The one of the first component also comprises a groove (see trapezoidal shaped groove 62) into which a protrusion extends from the third component (70). These modifications help to keep the device in alignment and to aid in compacting the bone in use. The two portions are capable of moving relative to one another, and in addition to the bores in between the two portions are capable of creating a space or opening depending on how each is actuated or moved.

Claim Rejections - 35 USC § 103

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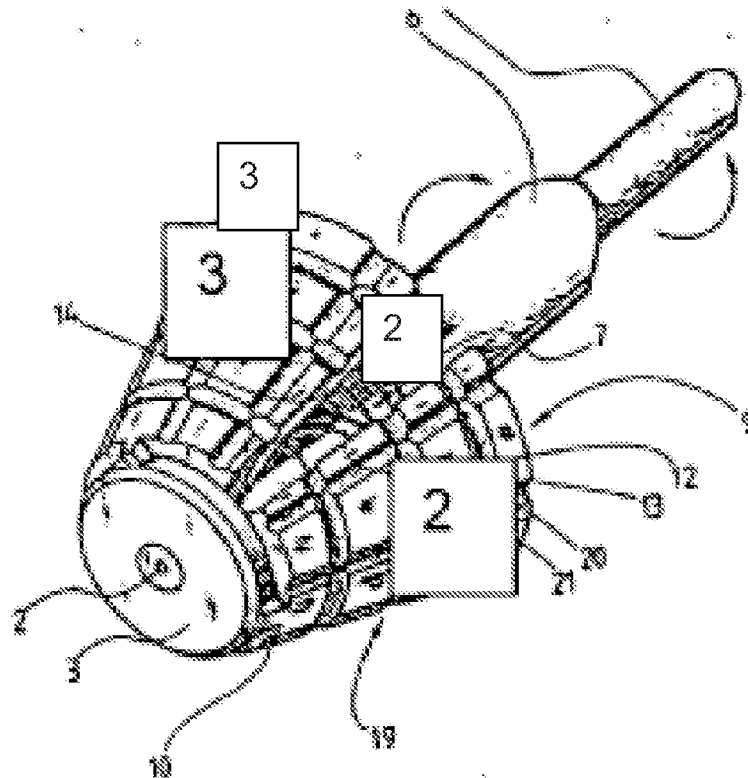
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, and 20-22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parhofer et al. (For Pat DE3630069) in view of Termanini (US Patent 4,237,875).

Parhofer et al. disclose a device having a first component defining a longitudinal axis (see Fig. 3, item 1), and a second component (19) movably associated with the first component (see joint at 10) in a radial direction (Fig. 2) and are separable by the an opening. The device further has a body (Fig. 3), and a stem extending from said body (6), and wherein the second component is tapered (Fig. 1). The device also has a restraining portion (8) and a cooperating portion of the second component (10) to provide restrained motion. The device also has a third component moveably associated with the first component (See Fig. 2 below, and the section denoted as "3" is the third component).

Fig. 2



Further, the internal side of component 2 has a surface associated with the first component (on the inside) while the second component has a surface capable of contact with bone material and that is also capable of urging the particles radially (see Col. 2 through Col. 3). The device also provides for a motion of the second component away from the longitudinal axis of the first component as the first component is advanced axially (Col. 5, lines 41-63).

Parhofer et al. disclose the claimed invention except for a groove and protrusion that helps to regulate the actuation between the moveable components. Termanini teaches an instrument that is capable of compressing bone with components that interact with a groove (3) and protrusion (8) see Figs. 3 and 4. They are considered to have sliding movement with respect to one another. It would be an obvious modification

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to have multiple components as taught by Parhofer et al. See also Col. 3. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Parhofer et al. having at least the grooves and protrusion in view of Termanini to have improved actuation when compating bone.

Response to Arguments

Applicant's arguments with respect to claims 6, 14, 20-22, 24-26, 29-31 have been considered but are moot in view of the new ground(s) of rejection.

It is noted that the claims addressed for the rejection under 35 USC 103 have been corrected.

It is held that the prior art of record still reads on the claimed invention. With regards to the structure of Wack not having movement with respect to the parts, the claims require that the parts be movably associated. As they are implanted, they are considered at least movably associated with one another, as a surgeon must place the parts in correspondence with one another, per the patient's needs. With regards to functional limitations of the claims, they do not impose any structural limitations on the claims distinguishable over Wack which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is (571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/
Examiner, Art Unit 3775

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733